

REMARKS

The applicants have carefully considered the Office action dated March 22, 2007 and the references it cites. In view of the following, it is respectfully submitted that all pending claims are in condition for allowance and favorable reconsideration is respectfully requested.

The Office action rejected all previously pending claims as being unpatentable over one or more of Houston, U.S. Patent 6,353,929, and one or more of Ozkan, U.S. Patent 6,031,577, Lotspiech et al., U.S. Patent 6,118,873, Gerace, U.S. Patent 5,848,396, Ciciora, U.S. Patent 5,815,297, Williams, U.S. Patent 6,259,443, Kaufman, U.S. Patent 5,003,591, and Saito, U.S. Patent 6,751,221. The applicants respectfully traverse these rejections.

In reviewing the rejections, it is clear that the Office action has largely repeated the prior rejections with the Houston Patent substituted in place of the Aras Patent. The applicants note they are very familiar with Houston, the primary reference relied upon by the Office action, as it is commonly owned with the instant application by Nielsen Media Research. As noted by the Office action, *Houston does not teach or suggest collecting PID headers* as recited in independent claims 13, 61, and 79. Thus, *Houston has the exact same deficiency as Aras* from the perspective that neither teaches nor suggests the collection of PID headers. Furthermore, Houston, like Aras, already has mechanisms for collecting detailed information from the payloads of the monitored media and, thus, has no need to log PID headers. As a result, for the exact same reason that the rejections based on Aras were in error and had to be withdrawn, the rejections based on Houston are likewise unsustainable. Indeed, the rejections based on Houston are completely inconsistent with the prior positions taken by the USPTO.

Specifically, as noted by the applicants in overcoming the prior rejections based on Aras, the U.S. Patent & Trademark Office had previously demonstrated that there was no motivation to modify Aras to collect PID headers since Aras already collected information derived from the payload portion without collecting the PID itself. In particular, the parent of this application, namely, US patent application serial number 09/076,517 (the “parent application”) included claims which were copied in an effort to provoke an interference with Massetti, U.S. Patent 5,974,299 (the “’299 Patent”). The applicants filed a request for reexamination of the ‘299 Patent based on the Aras patent and other references. In the reexamination of the ‘299 Patent (Control No. 90/007,057), the USPTO issued a Notice Of Intent To Issue Ex Parte Reexamination Certificate stating:

The examiner notes that Aras teaches recording private data of MPEG, but the private data is not in a control stream that is used to select the digital streams of the channel, wherein the control stream is used to allocate digital frames to the digital streams. In addition, Aras teaches MPEG, which inherently (as per the MPEG specification) teaches PIDS which are extracted identification codes from a control stream, but *Aras fails to teach or suggest recording the PID ... along with the time [of] reception, in that Aras teaches recording the payload data of the PID, and which has more information than the PID alone. Consequently, there is no motivation to store the PID information of Aras in that the Aras system already has similar information (derived from the payload portion but not the PID per se) stored.*

(Control No. 90/007,057, Notice of Intent to Issue Ex Parte Reexamination Certificate dated April 3, 2006, Statement of Reasons for Patentability and/or Confirmation, Pages 12-13)(emphasis added). Therefore, *the USPTO has already correctly concluded* that Aras does not teach or suggest recording a program identification (PID) header to identify a television program tuned by digital television equipment. On the contrary, as noted by the USPTO in its

earlier decision, “*Aras fails to teach or suggest recording the PID ... along with the time [of] reception, in that Aras teaches recording the payload data of the PID, and which has more information than the PID alone.*” (Id.)

This *exact same reasoning* applies to Houston. As acknowledged in the Office action, Houston fails to teach or suggest recording PID headers. Further, Houston teaches collecting payloads of packets associated with the PID headers and, thus, for exactly the same reason the USPTO has concluded that there is no motivation to modify Aras to collect the PID headers themselves, there is similarly no motivation to modify Houston to collect such PID headers. In the words of the USPTO from the above discussion of Aras:

[Houston] teaches recording the payload data of the PID, and which has more information than the PID alone. Consequently, there is no motivation to store the PID information of [Houston] in that the [Houston] system already has similar information (derived from the payload portion but not the PID per se) stored.

Therefore, for logical consistency between USPTO actions, it is clear that the rejection of the claims reciting the recordation of PIDs (i.e., independent claims 13, 61, and 79 and all claims depending therefrom), based on Houston are in error and must be withdrawn.

This point is further demonstrated by considering the alleged motivations to modify Houston noted in the Office action. In particular, the Office action of March 22, 2007 states:

At the time of the invention, it would have been obvious for one of ordinary skill in the art to use the PID headers taught by Ozkan in the system disclosed in Houston. The first motivation would have been that using a standardized program identifier, such as a PID header, would have given the system better interoperability with existing systems, which would be an advantage as Houston deals with the sharing of viewing records. The second motivation would have been that using the PID header enables the system to tune to sub-channels without

acquiring the program map table (PMT) (Ozkan; column 7, lines 47-54).

This is merely a rehash of the errored argument made in the final Office action. In particular, the argument is that it would be obvious to modify Aras/Houston to record and store PIDS in view of Ozkan because Ozkan reads PID headers to tune to the minor channels. However, while it is certainly true that Ozkan demonstrates that it was known to use PID headers to tune to programs, using PID headers to tune to programs provides no motivation to record and/or timestamp those PID headers. This is particularly true in the context of the Houston system. As already pointed out:

[Houston] fails to teach or suggest recording the PID ... along with the time [of] reception, in that [Houston] teaches recording the payload data of the PID, and which has more information than the PID alone. ***Consequently, there is no motivation to store the PID information of [Houston]*** in that the [Houston] system already has similar information (derived from the payload portion but not the PID per se) stored.

The Ozkan reference, which merely shows the well known usage of PIDs to tune to programs and is in no way directed toward recording and timestamping PIDS for audience measurement, does not add anything to the Houston reference and, thus, does not change the fact that there is no motivation to store the PID information of Houston because “the Houston system already has similar information (derived from the payload portion but not the PID per se) stored.”

The Office action goes further than the final Office action in alleging “a first motivation” and a “second motivation” for modifying Houston. However, neither of these alleged “motivations” are legally proper reasons for modifying Houston.

At the outset, it is noted that the mere fact that a modification has a beneficial result or advantage is not in and of itself a motivation to modify a reference. This point can be easily seen by considering the fact that every invention will of necessity have a beneficial result (i.e., an “invention” with no advantage over the prior art would be completely worthless and would never be the subject of patent protection). Therefore, merely identifying an advantage associated with a modification can never be a legally recognizable basis for modifying a reference, or *only useless inventions with no advantage* over the prior art can ever be patentable. This point is underscored by the US Supreme Court’s recent decision in KSR Int’l Co. v. Teleflex, Inc., 550 U.S. ____ 2007, 207 WL 1237837 (2007):

A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. ... ***This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.***

KSR, 207 WL at Page 10 (emphasis added). Therefore, since most inventions are combinations of old elements, and since all inventions will be associated with one or more identifiable advantages, were it possible to reject a claim as obvious by merely identifying one or more advantages or beneficial results to putting the elements of a claimed invention together, then there will be virtually no patentable inventions; a clearly absurd and unconstitutional result.

Looking specifically to the first and second alleged motivations, it can be seen that they fall precisely into this category of improperly using any conceivable advantage as a roadmap to reconstruct the invention. For example, the rejection states “The first motivation would have been that using a standardized program identifier, such as a PID header, would have given the

system better interoperability with existing systems, which would be an advantage as Houston deals with the sharing of viewing records.” This motivation makes no sense in the context of Houston, since Houston already uses “standardized program identifiers” (See Houston, col. 4, lines 40-44) and, thus, a person of ordinary skill in the art would have no reason to modify Houston to collect PID headers in order to obtain “standardized program identifiers.” Indeed, since the Houston system inserts its own standardized program identifiers into programming, the program identifiers used by Houston are likely to be more “standardized” and informative for Houston’s audience measurement purposes than PID headers which are clearly not intended for audience measurement. Accordingly, absent reference to applicants’ disclosure, a person of ordinary skill in the art reviewing Houston and Ozkan would have no reason to modify Houston to collect PID headers.

Further, collecting PID headers in Houston would not “have given the system better interoperability with existing systems” as falsely alleged in the “first motivation,” since the PID headers would neither provide more information than Houston was already collecting nor enable Houston to perform any other action that it could not already perform. Therefore, the “first motivation” alleged by the Office action is plainly fiction. It amounts to nothing more than a hindsight effort to manufacture a rationale for modifying Houston for the express purpose of re-creating the applicants’ claims. It is not a motivation based on evidence or reasoning uninformed by the applicants’ claimed invention. As such, it is not a legally cognizable rationale for modifying Houston.

The alleged “second motivation” is likewise flawed. The second motivation (i.e., “The second motivation would have been that using the PID

header enables the system to tune to sub-channels without acquiring the program map table (PMT)”) makes no sense in the context of Houston. Houston is an audience measurement system. It is not a tuning device and does not seek to effect how audience members utilize their tuning devices or how such tuning devices operate to tune programs. Instead, the focus of Houston is upon monitoring how audience members utilize their tuning devices. As such, there is absolutely no reason to modify Houston to enable tuning of any sort, let alone tuning “to sub-channels without acquiring the program map table (PMT).” Quite plainly, this second “motivation” is nothing more than a creative attempt to reconstruct the claimed invention through hindsight. However, the Supreme Court has again made it clear that:

A fact finder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning. See *Graham*, 383 U.S. at 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and “guard against slipping into the use of hindsight”) (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg & Supply Co.*, 332 F.2d 406, 412 (CA6 1964)).

KSR, 207 WL at Page 12. Thus, it is very clear that the law of the land continues to preclude the USPTO from utilizing the teachings of the invention to piece together the invention from the prior art. Since, absent hindsight reference to the applicants’ disclosure, there is absolutely no rationale for modifying Houston to collect PID headers as recited in claims 13, 61, and 79, the rejections of claims 13, 61, 79 and all claims depending therefrom based on Houston are in error and must be withdrawn.

Independent claim 62 is also in condition for allowance. Claim 62 recites an apparatus for identifying a viewer selected television program received by digital television program reception equipment which has a data

port to export tuned data. The apparatus comprises, among other things, a reader connected to the data port of the digital television reception equipment to read program identifying data tuned by the digital television program reception equipment from among data *exported* from the digital television program reception equipment via the data port, *wherein the data port operates in accordance with the IEEE 1394 protocol and the program identifying data read by the reader are identifier tags exported with the data in accordance with the IEEE 1394 protocol*. No combination of the art of record teaches or suggests such a reader.

The Office action attempts to find such a reader in Ozkan at Column 8, lines 13-20. Presumably, the Office action is alleging that one of the sub-picture processor 30, the decoder 25 or the decoder 35 is the reader, and the demultiplexer 22 is the digital television reception equipment of claim 62. However, such a reading of Ozkan does not fit claim 62 in that the sub-picture processor 30, the decoder 25, the decoder 35 and the demultiplexer 22 are all *internal* to a single device, namely, the decoder 100. Thus, it makes no sense to attempt to apply firewire (IEEE 1394 protocol) technology, which typically applies to home networking and/or interconnecting audio/video devices, to the Ozkan system.

Houston, like Ozkan, fails to disclose or suggest a data port that operates in accordance with the IEEE 1394 protocol or a reader to read program identifying tags exported via the data port in accordance with IEEE 1394 protocol. Indeed, Houston has no need of any such reader since Houston plainly collects detailed audience measurement information *within* the monitored equipment (e.g., a STB or other device), and, thus, has no need for, and makes no disclosure of, a reader connected to a data port of monitored

equipment to read program identifying data from data exported from the digital television reception equipment.

The Office action acknowledges this deficiency in the Houston/Ozkan combination, and looks to Saito for a rationale for modifying Ozkan/Houston to read on claim 62. However, while Saito clearly discusses the IEEE 1394 protocol, it provides absolutely no motivation to apply that protocol to Ozkan/Houston in a manner as to arrive at claim 62.

More specifically, the Office action argues that

it would have been obvious for one of ordinary skill in the art to use the firewire protocol to communicate upstream, as taught by Saito, in the system disclosed by Ozkan and Houston. The motivation would have been to enable multiple units to connect up to a single modem for upstream communication.

(Office action, Pages 16-17). However, this rationale makes no sense in the context of the claim. Specifically, using the firewire protocol to connect multiple units to share a modem for upstream communication might result in exporting the data collected by the Houston software agent within the monitored device, but it provides no rationale for completely changing the data collection mechanism of Houston from a software agent internal to a monitored media presentation device to a reader coupled to a data port of a monitored media presentation data that collects program identification tags output via the firewire port. In other words, the motivation proposed by the Office action *might* lead one to forward the data collected internally by the Houston software agent upstream to the central data collection center, but it would not lead one to replace the inventive Houston data collection mechanism with a reader as recited in claim 62.

In short, it is clear that none of Ozkan, Houston or Saito contemplate using a reader coupled to an IEEE 1394 data port to collect program identification tags. At most the Office action has identified a rationale for using IEEE 1394 communication protocols to transport data collected using the Houston cooperative media handler approach internal to the monitored device from the monitored device to an upstream device. The Office has failed to identify any teaching or suggestion for exploiting IEEE 1394 communication as a vehicle for collecting program identifying tags. Indeed, given Houston's access to detailed audience measurement information *within* the monitored equipment via the cooperative media handler, there is no need for a reader coupled to an IEEE 1394 port of the monitored equipment to record identifier tags exported via the IEEE 1394 port of the monitored equipment. Therefore, the only reason anyone would read the Houston/Ozkan/Saito combination as teaching such an external reader is with a priori knowledge of the invention of claim 62. Of course, such hindsight usage of the teachings of the applicants' invention is not a proper basis for rejecting the applicants' claims. Accordingly, it is respectfully submitted that claim 62 and all claims depending therefrom are in condition for allowance.

Independent claim 80 is also in condition or allowance. Claim 80 recites a method for identifying a viewer selected television program received by digital television program reception equipment which has a data port to export tuned data. The method comprises, among other things, reading program identifying data tuned by the digital television program reception equipment from among data exported from the digital television program reception equipment via the data port, wherein the data port operates in accordance with the IEEE 1394 protocol and the program identifying data

includes identifier tags exported with the data in accordance with the IEEE 1394 protocol. As discussed above, no combination of the cited art teaches or suggests such a method. Accordingly, claim 80 and all claims depending therefrom are in condition for allowance.

In view of the foregoing, it is respectfully submitted that all pending claims are in condition for allowance.

If the Examiner is of the opinion that a telephone conference would expedite the prosecution of this case, the Examiner is invited to contact the undersigned at the number identified below.

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